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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/765,962	01/29/2004	Frank Giesel	2694-0142P	2269
2292	7590	10/18/2006	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH			KURTZ, BENJAMIN M	
PO BOX 747			ART UNIT	PAPER NUMBER
FALLS CHURCH, VA 22040-0747			1723	

DATE MAILED: 10/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/765,962	GIESEL ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Benjamin Kurtz	1723

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1)  Responsive to communication(s) filed on 22 August 2006.

2a)  This action is **FINAL**.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

- 4)  Claim(s) 2,3,5-20 and 22 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) 2,3 and 16-18 is/are allowed.

6)  Claim(s) 5-15,19,20 and 22 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on 29 January 2004 is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 3/04.

4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_ .  
5)  Notice of Informal Patent Application  
6)  Other: \_\_\_\_ .

## DETAILED ACTION

### ***Specification***

1. The amendment filed 8/22/06 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The applicant has disclosed the apparatus consists of synthetic material but has not disclosed the foil being non-metallic. Non-metallic can cover a different scope from synthetic and is therefore not supported by the original disclosure.

Applicant is required to cancel the new matter in the reply to this Office Action.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 5-10 and 22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The applicant originally disclosed the apparatus consisting of a synthetic material. The additional claimed limitation of the foil being plastic narrows the scope beyond the original disclosure of a synthetic material as synthetic material covers materials that are not plastics.

***Claim Rejections - 35 USC § 102 and 103***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 22, 8, 10-13 and 15 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Ernryd et al. WO 98/46324. Regarding claim 22, Ernryd teaches an apparatus for separating amalgam from dental sewage the apparatus having a flow zone and a sedimentation zone arranged in a housing (1) the housing comprising: an aperture (2) for sewage supply, an aperture (3) for sewage discharge, an inlet chamber (4), a passage chamber containing a separator (10) made of a plurality of layers of synthetic foil, an outlet chamber, and stands, the separator being a form body which can be streamed through and includes several tight fitting layers of structured plastic foil, the form body being fixed in the passage chamber, whereby the apparatus consists of recyclable synthetic material, and the housing is sealed in a liquid-proof manner except for the sewage supply and discharge apertures (fig. 1, page 2, lines 15-28). Ernryd teaches the plates being made of a non-metallic material but does not specifically teach a plastic. It would

have been obvious to one of ordinary skill in the art at the time the invention was made to make the plates plastic as plastic is easily manufactured, light weight and cheap.

Regarding claims 8, 10-13, and 15, the structured plastic foil provides continuous longitudinal structures as seen in the flow direction of the sewage (fig. 1); the structured plastic foil provides lamellar (thin plate) structures (fig. 1); the sedimentation surfaces of the structured foil are roughened by the addition of bumps (page 2, lines 15-28); a perforated plate 5 is arranged between the inlet chamber and the passage chamber, the holes provide sinkings on the side that faces the flow (fig. 1); the inlet chamber provides a flow guidance element (5) that is arranged in the upper area of the inlet chamber (fig. 1); and the sewage outlet provides a flow regulator (17).

4. Claims 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ernryd (324). Ernryd teaches a cross-section of the separator and of the housing but does not teach a particular cross-section area for either the separator or the housing. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have made the separator or the housing of Ernryd having the cross sectional area being round, oval or square because it has been held to be the configuration of an invention was a matter of choice which a person of ordinary skill in the art would have found obvious absent persuasive evidence that the particular configuration of the claimed invention is significant. *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966).

5. Claims 5-7 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ernryd (324) in view of Lee et al. US 5 700 378. Regarding claims 5-7, Ernryd

teaches the apparatus of claim 22 but does not teach a structured foil and a plain foil arranged alternatingly or a plisse structure. Lee teaches a separator (14) having element (16) formed of structured foil (40) having a plisse structure consisting of triangles where a structured foil and a plain foil are arranged alternatingly, is a wound structure, and is a tubular element made of structured foil (fig. 6d). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the separator structure of Lee because it efficiently separates difficult to separate particles (col. 2, lines 17-18).

6. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ernryd (324) in view of Kopp US 1 902 171. Ernryd teaches the apparatus of claim 22 but does not teach a vent channel being arranged in connection to the sewage outlet. Kopp teaches an apparatus having a housing comprising an inlet chamber (2), a passage chamber (3) containing a separator (13), and an outlet chamber (4), wherein in the uppermost position of the passage chamber above the separator a vent channel (18) is arranged which has a connection to the sewage outlet (19) in the outlet chamber (fig. 1). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the vent channel of Kopp to facilitate the flow of sewage in the event the separator become clogged (pg. 2, lines 38-47).

7. Claims 2-3 and 16-18 are allowed. Claim 2, as rewritten in independent form, contains the limitation of the apparatus having hollow stands where the hollow stands contain a pressure chamber combined with pressure sensors. Ernryd (324) teaches the apparatus but does not teach hollow stands having a pressure chamber or a pressure sensor. Herbert DE 4 243 239 teaches an apparatus having stands (at the bottom of the containers) combined with pressure sensors (12, 26) but does not teach the stands being hollow or the stands containing a pressure chamber. The combination of a hollow stand with a pressure chamber distinguishes over the prior art and is therefor allowable.

#### ***Response to Arguments***

8. Applicant's arguments filed 8/22/06 have been fully considered but they are not persuasive. The applicant has argued that Ernryd does not teach the apparatus having layers of foil and is not a recyclable synthetic material. Ernryd teaches layers of foil (12) (fig. 1, pg. 4, lines 5-9) and the apparatus consists of recyclable synthetic material, as synthetic means man-made, and materials of Ernryd are man-made and are recyclable (pg. 2, line 22).

#### ***Conclusion***

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin Kurtz whose telephone number is 571-272-8211. The examiner can normally be reached on Monday through Friday 8:00am to 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda Walker can be reached on 571-272-1151. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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